



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/233,218	01/20/99	CAJACOB	C 04983.0025.U

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EXAMINER

KIM, Y

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

08/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/233,218

Applicant(s)

CAJACOB ET AL.

Examiner

Young J. Kim

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1 and 2, drawn to a nucleic acid molecule that encodes a maize or soybean tetrapyrrole pathway enzyme, SEQ ID Nos. 586, 590, 594, 596, 597, 599, 600, 601, 604, and 605 and a species election of t-RNA reductase enzyme, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it would not pose an undue burden to search all the claims as a single entity. Applicants further argue that examination of more than 10 sequences for the nucleic acid molecules of claims 1 and 2 would not present an undue burden due to the interrelationship between the disclosed sequences. Finally, applicants traverse the election of species because the species are related in that the claimed nucleic acids and enzymes are all associated with the tetrapyrrole pathway in plants. This is not found persuasive because the structures of nucleic acids of I and enzymes of II, although might be related, comprise different structure and different functions, ultimately resulting in different searches being made. In regards to applicants traversal to the election of 10 SEQ ID Nos, each single SEQ ID Number is searched in all commercial, in-house, and issued databases. Therefore, searching of 10 SEQ ID Number alone, comprise searching in multiple databases for each of the 10 SEQ ID Numbers. Furthermore, applicants are given one SEQ ID Number per application (as discussed in the written Restriction/Election Requirement), this practice is partially waived and Applicants are given up to ten SEQ ID Numbers per application. Finally, applicants' traversal of election of species is not persuasive because although the enzymes might be associated with a particular pathway, each claimed species is structurally distinct and would require searches in addition to the nucleic acids and their 10 SEQ ID Numbers in multiple databases, resulting in an

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undue search burden to the Office. Furthermore, the 10 Sequence Restriction applies to all of the claims being examined.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are indefinite for inventions being drawn to SEQ ID Nos which are non-elected. Amending the claim to recite, "...nucleic acid sequence selected from the group consisting of SEQ ID NO: 586, 590, 594, 596, 597, 599, 600, 601, 604, and 605," overcome this rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1 and 2 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or a well established utility.

Definitions: [from REVISED INTERIM UTILITY GUIDELINES TRAINING

MATERIALS; repeated from <http://www.uspto.gov/web/menu/utility.pdf>]

"Credible Utility" - Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being "wrong". Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based is inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore, the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests (see below).

"Specific Utility" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a claim to a polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker" would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

"Substantial utility" - a utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a "substantial utility" define a "real world" context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a "real world" context of use in identifying potential candidates for preventive measures or

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further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.

B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. § 101.)

C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".

D. A method of making a material that itself has no specific, substantial, and credible utility.

E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

Note that "throw away" utilities do not meet the tests for a *specific* or *substantial* utility. For example, using transgenic mice as snake food is a utility that is neither specific (all mice could function as snake food) nor substantial (using a mouse costing tens of thousands of dollars to produce as snake food is not a "real world" context of use). Similarly, use of any protein as an animal food supplement or a shampoo ingredient are "throw away" utilities that would not pass muster as specific or substantial utilities under 35 U.S.C. § 101. This analysis should, of course, be tempered by consideration of the context and nature of the invention. For example, if a transgenic mouse was generated with the specific provision of an enhanced nutrient profile, and disclosed for use as an animal food, then the test for specific and substantial *asserted* utility would be considered to be met.

"Well established utility" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. "Well established utility" does not encompass any "throw away" utility that one can dream up for an invention or a nonspecific utility that would apply to virtually every member of a general class of materials, such as proteins or DNA. If this is the case, any product or apparatus, including perpetual motion machines, would have a "well established utility" as landfill, an amusement device, a toy, or a paper weight; any carbon containing molecule would have a "well established utility" as a fuel since it can be burned; any protein would have well established utility as a protein supplement for animal food. This is not the intention of the statute.

[See also the MPEP at §§ 2107 - 2107.02.]

The claimed nucleic acid which encodes glutamyl-tRNA reductase enzyme is not supported by a specific asserted utility because the disclosed use of the nucleic acids and enzyme are not specific and are generally applicable to any nucleic acid. For example, page 57 of the specification refers to such nucleic acids as ones that are "hybridizable" to nucleic acid sequences which encode the reductase enzyme. Furthermore, stating that the nucleic acid compounds may be useful as probes as detection markers or for assisting in the isolation of full-length cDNAs or genes which would be used to make protein and optionally further usage to make the corresponding antibodies, isolation of homologous sequences, detection of gene expression such as in Northern blot analysis, and for numerous other generic genetic engineering usages, absent specific enabling disclosure, is not considered a substantial and specific utility. Additionally, the glutamyl-tRNA reductase enzyme which is encoded by the claimed nucleic acids also lack specific asserted utility because the disclosed use of the enzyme is not specific. Any enzyme could be used for the purpose of studying its structure and its behavior. Since the enzyme lacks a substantial and specific utility, the claimed nucleic acid which encodes this protein, in turn, also lacks substantial and specific utility.

These are non-specific uses that are applicable to nucleic acids and enzymes in general and not particular or specific to the nucleic acids and enzyme being claimed.

Further, the claimed nucleic acid and enzyme are not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. The need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial

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utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acid have asserted or identified specific and substantial utilities. The research contemplated by applicants to characterize potential protein products, especially their biological activities, does not constitute a specific and substantial utility. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility has not been assessed. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid and/or protein compound(s) such that another non-asserted utility would be well established for the compounds.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 2 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or

a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ilag et al. (1994).

Claim 1 is drawn to a substantially purified nucleic acid molecules that encodes a maize or soybean tetrapyrrole pathway enzyme of fragment thereof selected from the group consisting of multiple species of enzymes.

Ilag et al. discloses a nucleic acid sequence encoding glutamyl t-RNA reductase which shows 69.1% local similarity match to the claimed SEQ ID NO. 586; 63.9% local similarity to SEQ ID NO. 590; 64.8% similarity to SEQ ID NO. 594; 70.1% to SEQ ID NO. 596; 70.8% similarity to SEQ ID NO. 597; 62.4% similarity to SEQ ID NO. 599; 65.6% similarity to SEQ ID NO. 600; 65.4% to SEQ ID NO. 601, 69.1% similarity to SEQ ID NO. 604; and 69.7% similarity to SEQ ID NO. 605 (see Sequence Homology Search), thus encoding a fragment of all the of the sequences as claimed.

Therefore, Ilag et al. anticipate the invention as claimed.

No claim is allowed.

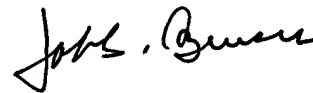
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Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (703) 308-9348. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028. Papers related to this application may be submitted to Art Unit 1631 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. The Fax number is (703) 308-0294. Please call the Examiner at (703) 308-9348 before the transmission to expedite delivery of the fax. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Young J. Kim

08/25/00



JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER